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AUG 26 2008

OFFICE OF PETITIONS

In re Application of	:	
Ruy Tchao	:	
Application No.: 09/472490	:	DECISION ON
Filing or 371(c) Date: 12/23/1999	:	PETITION
Attorney Docket Number: 102-302RE/CO	:	

This is a decision in response to the Petition to Withdraw Holding Abandonment Based on Failure to Receive Office Action under 37 CFR 1.181(a), filed June 11, 2008.

This Petition is hereby **dismissed**.

The above-identified application became abandoned for failure to timely and properly reply to the final Office action, mailed December 22, 2004, wherein the Examiner rejected claims 46-50. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a).

Applicant filed a Notice of Appeal in response to the Office action on March 21, 2005, and Appeal Brief on May 19, 2005. The Examiner filed an Answer on June 14, 2006. A Request for Oral Hearing and Reply Brief were filed July 31, 2006. On October 24, 2006 the Board of Patent Appeals and Interferences ("Board") entered an "Order Returning Undocketed Appeal to Examiner," to hold the Appeal Brief Defective and to have the Examiner consider an Information Disclosure Statement ("IDS"). The Examiner mailed a Notice of Non-Compliant Appeal Brief on November 8, 2006. In response to the Notice, Applicant filed an Appeal Brief on December 8, 2006; the Examiner filed an Answer on February 23, 2007, and Applicant filed a Reply Brief on April 19, 2007.

On June 7, 2006, the Board again entered an "Order Returning Undocketed Appeal to Examiner," to have the Examiner consider the IDS. Thereafter the case was docketed, and the Board issued a Decision on January 28, 2008, affirming the rejection of claims 46-50 under the judicially created doctrine of obviousness patenting of claims 1-19 of RE38,383 E; affirming the rejection of claims 46-50 under 35 U.S.C. § 251 based on a defective reissue oath/declaration, and reversing the Examiner on claims 46-48 and 50 under 35 U.S.C. § 112, first paragraph, for lack of enablement, and reversing the Examiner's rejection of claims 46-48 and 50 under 35 U.S.C. § 251 as improperly broadening the scope of the claims of Patent No. 5,601,997. The case was returned to the Examiner for action consistent with the Board's Decision.

The Present Petition

Applicant files the present petition and states that the Examiner failed to issue an action consistent with the Board's decision, but only issued a Notice of Abandonment. Applicant's therefore petition to withdraw the holding of abandonment based on the failure to receive an Office action consistent with the Board's Decision.

Applicable Law, Rules and MPEP

37 CFR 1.197A, Return of jurisdiction from the Board of Patent Appeals and Interferences; termination of proceedings, provides

(a) Return of jurisdiction from the Board of Patent Appeals and Interferences.
Jurisdiction over an application or patent under ex parte reexamination proceeding passes to the examiner after a decision by the Board of Patent Appeals and Interferences upon transmittal of the file to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application or patent under ex parte reexamination proceeding may require, to carry into effect the decision of the Board of Patent Appeals and Interferences.

(b) Termination of proceedings.

(1) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§ 1.304) except:

(i) Where claims stand allowed in an application; or

(ii) Where the nature of the decision requires further action by the examiner.

(2) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action (§ 1.304) expires in the absence of further appeal or review. If an appeal to the U.S. Court of Appeals for the Federal Circuit or a civil action has been filed, proceedings on an application are considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

The MPEP 1214.06, Examiner Sustained in Whole or in Part, states:

The practice under the situations identified in paragraphs I-III below is similar to the practice after a decision of the court outlined in MPEP § 1216.01. Examiners must be very careful that case files that come back from the Board are not overlooked because every case, except applications in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. See MPEP § 1216.01 and § 1216.02 for procedure where court review is sought. The

time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the Director. See MPEP § 1216. When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve one or more of the following circumstances:

I. NO CLAIMS STAND ALLOWED

The proceedings in an application or ex parte reexamination proceeding are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files. In an ex parte reexamination proceeding, a reexamination certificate should be issued under 37 CFR 1.570.

MPEP 711.03(c)

Analysis

In this instance, all claims stood rejected after the Board's decision of January 28, 2008. The present application was held abandoned because Court proceedings were terminated on January 28, 2008. A Notice of Abandonment was mailed May 12, 2008.

The MPEP 1216.01(I)(A) states:

If all claims in the case stand rejected, proceedings in the case are considered terminated on the >issue< date ** of the Federal Circuit's mandate. Because the case is no longer considered pending, it is ordinarily not open to subsequent amendment and prosecution by the applicant. *Continental Can Company v. Schuyler*, 326 F. Supp. 283, 168 USPQ 625 (D.D.C. 1970). However, exceptions may occur where the mandate clearly indicates that further action in the U.S. Patent and Trademark Office is to be taken in accordance with the Federal Circuit's opinion.

In view of the above, the Notice of Abandonment mailed May 12, 2008 was proper and the application is being returned to abandoned status.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
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Office of Petitions